REMARKS

Applicant submits that the present amendment is fully responsive to the Office Action dated September 17, 2009 and, thus, the application is in condition for allowance.

By this reply, claims 1, 15, and 25 have been amended. Claim 13 remains withdrawn. Claims 1, 3-5, 8-10, 15-23, and 25 are currently pending in the application. Of these, claims 1, 15, and 25 are independent. An expedited review and allowance of the application is respectfully requested.

In the outstanding Office Action, claims 15 and 25 were rejected under 35 U.S.C. § 101 because it is alleged that the claimed invention is directed to non-statutory subject matter. It is asserted that there is no structure recited in claim 15 to give structure to the claim, thus it falls outside of the statutory classes of invention and is merely software per se. Regarding claim 25, it is asserted that this is merely a computer program and is merely software per se. The Office Action recommends amending the preamble to state that when the computer-readable media is executed by hardware it causes those steps to take place. Applicant has modified both claims 15 and 25 to recite structure, as suggested. Thus the rejection should be withdrawn.

In the outstanding Office Action, claims 1, 3-6, 8-9, 15-22, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ostermann et al. (US 6963839) in view of Isaacs et al. (US 2004/0215728). It is asserted that Ostermann discloses substantially each element of the present invention as recited in the claims but for determining if the recipient has a file prior to sending the file. It is further asserted that Isaacs does disclose this deficiency and that the combination of these cited references would have therefore been obvious to one having ordinary skill in the art. Applicant respectfully traverses.

With respect to independent claims 1, 15, and 25, Ostermann does not disclose or fairly suggest the present invention as recited in the pending claims. For example, Ostermann fails to teach or suggest, among other things, "displaying the sender-generated message and the emoticon, and audibly playing the sound file linked to the emoticon." These elements are disclosed in paragraph [0026], and are recited in claims 1, 15, and 25, as amended. The present invention is directed to a method for linking sounds and emoticons to allow a first user or sender to send an emoticon to a recipient or second user such that the recipient sees the emoticon and hears a sound associated with it (paragraph [0006]). The message is received at the end user and is displayed on a device such as a computer screen, PDA, cellular telephone, pager, Internet appliance, etc. (paragraph [0026]). Along with the displaying of the message and the emoticon or emoticon symbol, the device also plays the audio file that has been linked to the emoticon paragraph [0026]). The recipient views the message on the screen, the message composed of text and emoticons.

In sharp contrast, Ostermann discloses a method for customizing a voice in a multi-media message (Ostermann, abstract). For example, a multi-media message includes a designation of an animated entity for audibly delivering the message and emoticons that add emotional elements to the animated entity during the delivery of the message (Ostermann, col. 4, line 67 – col. 5, line 4). Once the sender finishes creating the multi-media message and sends the message, the Internet transmits the message text with emoticons to a text-to-speech server that communicates with an animation or face server to compute and synchronize the multi-media message (Ostermann, col. 5, lines 7-12). The animation server processes the received phonemes, message text, emoticons and any other provided parameters such as background images or audio and **creates an animated message** that matches the audio and the emoticons (Ostermann, col. 5,

lines 21-25). The system encodes the audio and video portions of the multi-media message for streaming through a streaming audio/video server (Ostermann, col. 5, lines 36-38). Alternately, the device locally renders the animation including sounds (Ostermann, col. 6, lines 1-15). In either case, the message is not actually displayed in its text form, and thus the emoticons are never displayed to the recipient. Thus, the elements "displaying the sender-generated message and the emoticon" are not taught or fairly disclosed in Ostermann.

Furthermore, a sound file, as in the present invention, is stored on a database or transferred to the recipient's device (paragraph [0029]). This implies that the sound file is of a prerecorded nature. Ostermann, in contrast, employs a text-to-speech algorithm which renders sound as it is streamed to the recipient's device (Ostermann, col. 5, lines 21-25). There do not appear to be any sound files, as described in the present invention, in Ostermann. Thus, Ostermann does not teach or fairly disclose "audibly playing the sound file."

Finally, Isaacs cannot cure the deficiencies of Ostermann because Isaacs also fails to disclose at least these elements of the present claims stated above with respect to Ostermann. Isaacs is directed to a system for transmitting earcons, not emoticons (Isaacs, paragraph [0019]). The sender selects an icon (not an emoticon) and the system transmits a corresponding sound to the recipient without the icon. In other words, the invention of Isaacs transmits only sound, not any corresponding text or image. Emoticons allow a user to visually represent an emotion. An emoticon is not even mentioned in Isaacs. Because an emoticon is not even mentioned, "displaying the sender-generated message and the emoticon" cannot possibly be disclosed. Thus, Isaacs cannot cure the deficiencies of Ostermann. Therefore, the rejection should be withdrawn.

Thus, neither Ostermann nor Isaacs, alone or in combination, teach all of the elements in the independent claims. Hence, the dependent claims, which depend therefrom, also are patentably distinct from any prior art of record. For this reason, Applicant respectfully requests withdrawal of the rejection. Furthermore, there is no motivation to combine any of these references outside of Applicant's own disclosure. Even if they were combinable, *arguendo*, the combination would not be able to obviate the present invention for at least the reasons set forth above. Thus, the rejection of the claims should be withdrawn.

Claims 3-5, 8-9, and 16-22 are all dependent claims, dependent upon independent claims 1, 15, and 25. As dependent claims, each and every element of the respective independent claim is necessarily present in these dependent claims. Since Ostermann and Isaacs, alone and in combination, do not disclose each of the elements of the independent claims, all of the dependent claims, which depend therefrom, also are patentability distinct from any prior art of record. For this reason, Applicant respectfully requests withdrawal of the rejection.

Claims 10 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ostermann and Isaacs and in further view of Mages et al. (US 6463467). It is asserted that Ostermann and Isaacs teach all the features of the claims except for forwarding the emoticon and its line as a mime-encoded attachment. It is further alleged that Mages does disclose this deficiency and the combination of these cited references would have therefore been obvious to one having ordinary skill in the art. Applicant respectfully traverses.

With respect to claims 10 and 23, neither Ostermann, Isaacs, nor Isaacs, nor any other related art of record, alone or in combination, disclose or fairly suggest the present invention as recited in the pending claims. Claims 10 and 23 are both dependent claims, dependent upon

claims 1 and 15 respectively. As they are dependent claims, each element of the respective independent claim is necessarily present in them.

Mages is directed to a method for transmitting protected video or graphic data over the Internet from a Web site (Mages, Abs.). To the extent Mages discloses graphics or audio, it is not in the form of emoticons. Mages cannot cure the deficiencies of Ostermann and Isaacs with respect to the independent claims which have been stated above. Thus, the dependent claims, which depend therefrom, also contain deficiencies that Mages fails to cure. Therefore, Mages cannot cure the deficiencies of Ostermann and Isaacs. For at least this reason, Applicant respectfully request that the rejection be withdrawn. Furthermore, there is no motivation to combine any of these references outside of Applicant's own disclosure. Even if they were combinable, *arguendo*, the combination would not be able to obviate the present invention for at least the reasons set forth above. Thus, the rejection of the claims should be withdrawn.

No extension of time is believed due to enter this amendment. If any fees are associated with the entering and consideration of this amendment, please charge such fees to our Deposit Account 50-2882.

As all of the outstanding rejections have been traversed and all of the claims are believed to be in condition for allowance, Applicant respectfully requests issuance of a Notice of Allowance. If the undersigned attorney can assist in any matters regarding examination of this application, Examiner is encouraged to call at the number listed below.

Respectfully submitted,

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